

REMARKS

By this amendment, claims 76-96 are pending, in which no claims are canceled, currently amended, or newly presented. No new matter is introduced.

The Office Action mailed September 15, 2010 allowed claims 76-89 and rejected claims 90-96 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants appreciate the Office Action's indication of allowable claims and respectfully traverse the rejection.

With respect to the 35 U.S.C. § 112, first paragraph, rejection, the Office Action alleges that the recitation of "computer-readable storage medium" in claims 90-96 is not adequately supported by originally-filed disclosure. Applicants respectfully disagree.

"To satisfy the written description requirement, 'the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.'" *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed.Cir.1996)). "In other words, the applicant must 'convey with reasonable clarity to those skilled in *1372 the art that, as of the filing date sought, he or she was in possession of the invention,' and demonstrate that by disclosure in the specification of the patent." *Id.* (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed.Cir.1991)). Such disclosure need not recite the claimed invention in *haec verba*, but it must do more than merely disclose that which would render the claimed invention obvious. *Rochester*, 358 F.3d at 923; *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67 (Fed.Cir.1997).

Indeed, “[n]ot every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be.” *In re Gray*, 309 F.2d 769, 774 (C.C.P.A. 1962). In fact, “[a] patent is not a scientific treatise, but a document that presumes a readership skilled in the field of the invention.” *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1347 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556 (Fed. Cir. 1983) (holding that “[p]atents, however, are written to enable those skilled in the art to practice the invention, not the public”), *cert. denied*, 469 U.S. 851 (1984)). *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (“the test for sufficiency [of the written description requirement] is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date”).

In applying the above legal tenets to the facts of this case, Applicants respectfully submit that one having ordinary skill in the art would have recognized from the originally-filed disclosure that Applicants had possession of the now claimed invention at the time the application was filed. Specifically, claims 90-96 are directed to a server 28, which is depicted in Figures 1 and 3 of the present application. In particular, Figure 3 provides a detailed block diagram representation of the server 28, which in itself includes multiple servers 46, 48, 50, and 52, and other various computing elements. The present application clearly describes the components and computing processes associated with server 28 such as to allow persons of ordinary skill in the art to recognize that Applicants have invented what is now claimed.. For example, page 5, line 17 – page, 6, line 19, of the specification is reproduced below for ease of reference (emphasis added):

FIG. 3 is a more detailed block diagram representation of the server of the system of the network shown in FIG. 1. In FIG. 3, **the server 28 includes a support server 46, a response handler or application server 48, a network application server 50, and a directory server 52.** As would be appreciated by one of ordinary skill in the art the referenced connections do not depict the physical connections between the elements but merely logical connections. **The support server 46 provides services oriented towards enabling and supporting the services provided to the terminal 20.** The support server 46 includes an upgrade service unit 54, a bookmark service database unit 55, a login services unit 56, **a bookmark database 57, a profile services unit 58, a client log unit 59 for collecting information about clients,** an advertisement services unit 60, **a system log unit 61 for collecting information about events in the server 28 from the client log unit 59,** an administrative services unit 62, a defined services unit 64, and **a directory client unit 66.**

Still referring to FIG. 3, **the upgrade services unit 54 is dedicated to controlled software upgrade of the software for the support server 46.** Updates are transmitted from the global upgrade server 38 (in FIG. 1) to the upgrade service unit 54. The login services unit 56 provides for authentication of the user and the terminal 20 that is being used to access the services based on information provided by the client unit 66. Additionally, the login services unit 56 is also responsible for log-off activities, such as individual session termination. **The profile services unit 58 provides for modifying a user's profile information.** This modification of a user's profile may include modifying the group and individual information and preferences. The administration services unit 62 provides for administration of the support server 46 and the application server 48. The software product updates are transmitted from the global upgrade server 38 (in FIG. 1) and its configuration tool manager to the upgrade service unit 54 in FIG. 3 and its configuration tool client. **The configuration tool client is the function unit, that acts when any configuration tool manager 38 (in FIG. 1) of management server 37 (in FIG. 1) upgrades any software component, full executable software program or re-configures configuration parameters; application and system parameters.**

Applicants respectfully submit that the computing processes and functions (e.g., software upgrade, user/terminal authentication, user profile modification, etc.) of the server 28 (which includes multiple elements) would clearly be understood by one having ordinary skill in the art as being steps that are performed when one or more processors execute one or more sequences of instructions that are carried by a computer-readable storage medium. Thus, one having ordinary skill in the art would have undoubtedly recognized from the originally-filed disclosure that Applicants had possession of the now claimed invention at the time the present application was

filed. That is, one having ordinary skill in the art would have recognized that the “computer-readable storage medium” in claims 90-96 is adequately supported by originally-filed disclosure. Accordingly, withdrawal of the rejection is respectfully requested.

Therefore, the present application, as amended, overcomes the rejection of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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Date

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